

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed February 9, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 102(e)**

Claims 1-4, 7, 11, 13, and 30 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Garfinkle (U.S. Pat. No. 6,924,878). Applicant respectfully traverses this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Garfinkle reference. Applicant discusses the Garfinkle reference and Applicant’s claims in the following.

#### **A. The Garfinkle Disclosure**

Garfinkle discloses a method of processing a roll of exposed photographic film. Garfinkle, Patent Title. In the method, photographic film is sent to a developer 12 where the photographic film is developed and scanned to acquire digital images of the captured film images. Garfinkle, column 3, lines 45-53. The digital images are then stored on an

image server 16. Garfinkle, column 3, lines 49-53. The photographer 8 that captured the film images can then access the digital images using a browser and request various tasks, including printing the images. Garfinkle, column 6, lines 1-20.

## **B. Applicant's Claims**

Applicant's claim 1 provides as follows (emphasis added):

1. A method for facilitating pay printing, the method comprising:

*a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network;*

the printing service receiving print option selections; and

*the printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version.*

As a first matter, Garfinkle does not teach "a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network". In addressing this issue, the Examiner cited column 6, lines 1-25 of the Garfinkle reference. That portion of the reference provides as follows:

In a most preferred embodiment, the photographer 8 accesses HTML pages from a WWW browser using either the Secure HyperText Transport Protocol (HTTPS) or HyperText Transport Protocol (HTTP) to access a Netscape Enterprise Server running on an Axil 320 Sparc acting as the image server. The Netscape server is configured with an HTML forms interface which accepts the unique access code and provides access

to thumbnails (small replicas of the full digital image) of the images in the roll in the form of an online proof sheet. The interface B allows the photographer 8 to perform specific tasks using the digital images, such as the ability to electronically mail (e-mail) an image to another party; download an image to the photographer's home computer 9f, see FIG. 9C; or order a visual print of a specific image in a variety of formats and sizes, such as photographic prints or enlargements of photographic prints, and photographic merchandise including T-shirts, sweatshirts, mugs, mouse pads, puzzles, ties, buttons, electronic slide shows, and other items bearing the digital image.

It will be appreciated that when downloading or e-mailing a digital image, the resolution of the digital image is preferably reduced to a screen size of 600×400 pixels or 712×512 pixels. These sizes are more appropriate for screen display of the digital images, and allow faster transfer of the data over a network.

[Garfinkle, column 6, lines 1-25]

In the above excerpt, it is the *photographer* who retrieves an online proof sheet that contains small replicas of his images, not any “printing service”. Therefore, Garfinkle fails to anticipate claim 12 for at least that reason.

Irrespective of the above, it is abundantly clear that Garfinkle fails to teach a “printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version”. As to this issue, the Examiner identified column 9, lines 53-65, which provide:

When the photographer 8 uploads one or more digital images directly to the image server 16, these images are either added to a set of images already associated with an access code or the new images are

assigned a new unique access code. When a new access code is assigned, a price sheet must be associated with these images in order to provide to the photographer 8 the visual prints which may be ordered using the new images. In a preferred embodiment, the photographer 8 selects a fulfillment center 20 which they prefer to use to fulfill all orders placed using the new images. A price sheet is associated with each fulfillment center 20, and this price sheet forms the basis for the products available to the photographer 8, and the prices of these products.

[Garfinkle, column 9, lines 53-65]

As can be appreciated from the above, described in the excerpt are: (i) uploading new images to a server, (ii) assigning a new access code to the images, (iii) associating a price sheet with images, and (iv) selecting of a “fulfillment center” that will “fulfill all orders placed using the new images.” Clearly missing, however, is a teaching of determining printing costs based upon “attributes” of “scaled-down versions” of the images. Simply stated, Garfinkle fails to contemplate such a system or method. It is therefore clear that Garfinkle fails to anticipate a “printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version” as required by claim 1.

In view of at least the foregoing, it is clear that Garfinkle does not anticipate claim 1, or the claims that depend from claim 1. Accordingly, Applicant requests that the rejections be withdrawn.

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Garfinkle in view of Official Notice. Applicant respectfully traverses this rejection.

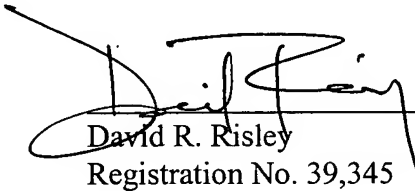
As is identified above, Garfinkle does not teach several aspects of Applicant's claim

1. Applicant therefore submits that claim 12, which depend from claim 1, is allowable over the Garfinkle for at least the same reasons that claim 1 is allowable over Garfinkle.

**CONCLUSION**

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

3-30-06  
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